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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,181	11/10/2000	Steven D. Jensen	7678.350.2	4245
22913	7590	03/31/2004	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY)			PRYOR, ALTON NATHANIEL	
60 EAST SOUTH TEMPLE			ART UNIT	PAPER NUMBER
1000 EAGLE GATE TOWER			1616	
SALT LAKE CITY, UT 84111			DATE MAILED: 03/31/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,181

Applicant(s)

JENSEN ET AL.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 41-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 41-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

I. Rejection of claims under 35 USC 112, 2nd paragraph will not be maintained.

Applicant has deleted "preventing" from the claims.

Applicant's arguments filed 12/11/03 have been fully considered but they are not persuasive. See arguments below.

II. Rejection of new claims 41,42,46-85 under 35 USC 102(b) as being anticipated by US '512 on record will not be maintained for reason on record and reason as follows.

Applicant argues that US '512 makes claims to an invention comprising 0.1 – 10% potassium nitrate; whereas, the instant invention claims 0.05 – 1% potassium nitrate.

Applicant argues that US '512 does not make claim to bleaching agent; whereas, instant application makes claim to a bleaching agent. Applicant argues that US '512 teaches that higher concentrations in the 0.1 – 10% range increases desensitization; whereas, instant invention shows that lower concentrations of bleaching agent (0.5 %) gives better desensitizing results than higher concentrations of the desensitizing agent (3% and above). Applicant argues that composition comprising a) 0 % potassium nitrate, 10% carbamide peroxide b) 0.5% potassium nitrate, 10.5% carbamide peroxide are more effective in desensitizing teeth than composition comprising 3% potassium nitrate and 10% carbamide peroxide. Examiner argues that the instant range of 0.05 – 1% potassium nitrate falls within the prior art range of 0.1 to 10% potassium nitrate.

Therefore, Examiner concludes that US '512 anticipates the instant invention. US '512 teaches the presence of bleaching agents (carbamide peroxide) in the prior art invention. See column 9 lines 18-27. Examiner agrees with Applicant's results.

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However, Examiner argues that claims are for broader than the unexpected results provided by the Applicant.

Claims 43-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 41,42,46-85 of U.S. Patent No. 5851512 in view of USPN 5985249 column 8 lines 48-62. US '512 teaches all that is recited by claims 43-45 except for the composition comprising 0.5 – 50% teeth bleaching agent. However, US '249 teaches a composition comprising 3-30% bleaching agent for whitening teeth. See column 8 lines 48-62. One would have been motivated to modify the invention of US '512 to include 3-30% bleaching agent. One would have been motivated to do this in order to enhance the cleanness of teeth.

III. Double Patenting rejection of new claims 72-85 over US '576 on record will be maintained for reasons on record and reason as follows. Applicant argues that US '576 teaches up to 50% potassium nitrate and does not teach the instant range of 0.05 to 1% potassium nitrate. Examiner directs Applicant to claim 10 of US '576 which teaches up to 10% potassium nitrate. Examiner argues that up to 10% potassium nitrate means 0 to 10% potassium nitrate which covers the instant range of potassium nitrate.

IV. Double Patenting rejection of new claims 41,42,46-55,58-69,72-85 over US '625 will be maintained for reason on record and reasons as follows. Applicant argues that US '625 teaches up to 50% potassium nitrate and not the instant range of 0.05 to 1% potassium nitrate. Examiner directs Applicant to claim 3 of US '625 which teaches up to 50% potassium nitrate. Examiner argues that up to 50% potassium nitrate means 0 to 50% potassium nitrate, which covers the instant range of potassium nitrate.

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V. Double Patenting rejection of new claims 41-85 over US '370 will be maintained for reason on record and reason as follows. Applicant argues that US '370 does not teach or suggest 0.05 to 1 % potassium nitrate. Examiner directs Applicant's attention to claim 14 of US 370 which discloses 0.1 to 10% potassium nitrate which covers the instant range of potassium nitrate.

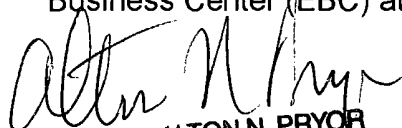
Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


ALTON N. PRYOR
Primary Examiner
AU 1616